

REMARKS/ARGUMENTS

Presently, all of the pending claims (1-22) stand rejected for the following reasons:

- Claims 6, 7, 14 and 18 are objected to for various informalities;
- Claims 1-5, 11-13 and 17, 18, 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S.P.N. 5,990,918 to Baxendale (“Baxendale”) and U.S.P.N. 4,897,533 to Lyszczarz (“Lyszczarz”); and
- Claims 6-10, 19 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baxendale as modified by Lyszczarz as applied to claims 1 and 18, and further in view of German Patent DE29622711U1 (“Louis”).

By this Amendment, independent claims 1 and 18 have been amended to place them in condition for allowance. Applicant asserts that these claim amendments and all claims dependent upon them are fully supported by the Application as filed and, as such, do not introduce new matter.

A. Objection to Claims 6, 7, 14 and 18 because of various informalities.

Applicant has amended claims 6, 7, 14 and 18 to correct or delete the informalities cited by the Examiner.

B. Rejection of Claims 1-5, 11-13 and 17, 18, 21 and 22 under 35 U.S.C. §103(a) as being Obvious over the Combination of Baxendale with Lyszczarz

Claims 1-5, 11-13 and 17, 18, 21 and 22 currently stand rejected under 35 U.S.C. §103 as being obvious over Baxendale in view of Lyszczarz. These rejections are traversed based on the following.

To properly reject a claim under 35 U.S.C. §103(a), the Manual of Patent Examining Procedure imposes a burden on the Patent Office to establish a *prima facie* case of obviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.

M.P.E.P § 2142. There are three basic criteria to a case of prima facie obviousness: i) there must be some suggestion or motivation to modify the references or combine the reference teachings; ii) there must be reasonable expectation of success in modifying or combining the references; and iii) the prior art references must disclose or suggest all of the limitations of the claimed invention. *Id.* In the present case, the Office Action has failed to establish, at a minimum, a teaching of all of the limitations of the claimed invention.

Neither Baxendale nor Lyszczarz disclose or suggest “providing a substrate having a reflective region covering a portion of the substrate substantially less than the entire surface of the substrate” as required by amended claim 1. The Office Action admits that “Baxendale fails to teach the substrate having at least one reflective region covering a portion of the substrate.” The Lyszczarz reference, however, teaches a substrate where approximately the entire surface of the substrate must be covered with a reflective material: “The metal containing layer is bonded to the first surface of the substrate and preferably covers at least substantially the entire first surface of the substrate.” Lyszczarz, col. 2, lns. 58-61 (emphasis added). Applicant has clarified this distinction by adding the requirement that the reflective region cover a portion of the substrate that is “substantially less than the entire surface of the substrate.” Furthermore, the Office Action admits “Baxendale as modified by Lyszczarz fails to specifically teach the substrate having an area/portions that are not covered by the reflective region.” Office Action of Feb. 24, 2004, p. 6. Since none of the cited references disclose or suggest a “substrate having a reflective region covering a portion of the substrate substantially less than the entire surface of the substrate,” the combination of Baxendale with Lyszczarz cannot render independent claim 1 obvious. Since claims 1, 3-5, 11-13, and 17 depend from claim 1, these claims distinguish from the combination of Baxendale and Lyszczarz for the same reasons as claim 1. For these reasons,

Applicant requests that the rejection of claims 1, 3-5, 11-13, and 17 as being obvious over the combination of Baxendale with Lyszczarz be reconsidered and withdrawn.

Much like claim 1, claim 18 has been amended to clarify that that reflective element is substantially less than the entire surface of the substrate and that the reflective element comprises a metal film suitable for increasing the visibility of an overlying security image. Since these amendments are substantially similar to the amendments of claim 1, claim 18 distinguishes from Baxendale and Lyszczarz for the same reasons as claim 1. Further, since claims 21 and 22 depend from claim 18, these claims distinguish from the combination of Baxendale and Lyszczarz for the same reasons as claim 18. Applicant therefore requests that the rejection of claims 18, 21, and 22 as being obvious over the combination of Baxendale with Lyszczarz be reconsidered and withdrawn.

Claims 14-16 are also rejected under 35 U.S.C. §103 as being unpatentable over Baxendale in view of Lyszczarz as applied to claim 1, and further in view of Peyret (US 5,688,056). Because each of these claims depend from independent claim 1, which has been distinguished over Baxendale and Lyszczarz, Applicant submits that the rejection of these claims has been traversed. Applicant therefore requests that the rejection of claims 14-16 be reconsidered and withdrawn.

C. Rejection of Claims 6-10, 19 and 20 under 35 U.S.C. §103(a) as Being Obvious over Baxendale as Modified by Lyszczarz as Applied to Claims 1 and 18 in View of Louis (DE2962271U1).

Claims 6-10, 19, and 20 currently stand rejected under 35 U.S.C. §103 as being unpatentable over Baxendale as modified by Lyszczarz in view of Louis. Initially, the Office Action admits that “Baxendale as modified by Lyszczarz fails to specifically teach the substrate

having an area/portions that are not covered by the reflective region.” Office Action, p. 6. But the Office Action also states that this missing element is taught by the “Louis” reference (DE 2962271U1):

Louis teaches a method and item including a substrate (14) having a reflective region/element (10), wherein the substrate has areas/portions that are not covered by the reflective region (see figure 2 and page 2 of the translation of the abstract).

Id. at 6. This rejection is respectfully traversed.

As stated previously, to establish a prima facie case of obviousness, there must be i) some suggestion or motivation to modify the references or combine the reference teachings; ii) a reasonable expectation of success in modifying or combining the references; and iii) a disclosure or suggestion of all of the limitations of the claimed invention. In the present case, none of the cited references (Baxendale, Lyszczarz, or Louis) teach a “reflective region covering a portion of the substrate that is substantially less than the entire surface of the substrate, wherein the reflective region comprises a metal film suitable for increasing the visibility of an overlying security image.” In addition, there is no motivation to combine the teachings of Baxendale and Lyszczarz with Louis.

The combination of Baxendale and Lyszczarz does not disclose or suggest “the substrate having an area/portions that are not covered by the reflective region.” Although Louis appears to suggest a metal film (10) that is deposited over a portion of a transparent lacquer (5), Louis has no disclosure or suggestion that this metal film is suitable for increasing the visibility of an overlying security image. In fact, Louis has no teaching or suggestion of any overlying security images. Moreover, Louis teaches that microscopic relief features (7) are incorporated into the underlying lacquer layer (5) so as to form a security element within the metal film (10) itself.

Since these relief features (7) would obscure any overlying security images, Louis teaches away from the requirement of claim 1 that a security image be placed over the metal film. For these reason, the combination of Baxendale, Lyszczarz, and Louis does not disclose or suggest all of the limitations of claim 1 and there is no motivation to combine these references either. Since claims 6-10 depend from claim 1, each of these claims distinguishes from Baxendale, Lyszczarz, and Louis for the same reasons.

Claim 18 is an apparatus claim that incorporates many of the same limitations of claim 1, namely the requirement of a “reflective element [comprising] a metal film suitable for increasing the visibility of an overlying security image.” Claim 18 therefore distinguishes from the combination of Baxendale, Lyszczarz, and Louis for the same reasons as claim 1. Claims 19 and 20 depend from claim 18 and therefore distinguish from these references for the same reasons. For these reasons, Applicant asks that the rejection of claims 6-10, 19 and 20 over the combination of Baxendale, Lyszczarz, and Louis be reconsidered and withdrawn.

CONCLUSION

Applicant respectfully submits that pending claims 1-22 are in condition for allowance, and requests a Notice of Allowance for the pending claims. Examiner is invited to contact the undersigned Attorney of Record if such would expedite the prosecution of the present Application. No fee based on the number or type of claims is believed to be currently due. Accompanying this present Amendment is a Petition for Extension of Time under 37 CFR 1.136(a), for one month, and the necessary filing fee. The Commissioner is hereby authorized to charge any deficient fees to complete this filing or credit any overcharge to Deposit Account No. 13-0480, referencing Attorney Docket Number 24141761.3.

Serial No. 10/038,403
Attorney Docket No. 24141761.3

If the Examiner has any questions or concerns, a telephone conference to the below-signed attorney of record is greatly appreciated.

Date: 6/24/2004

Respectfully submitted,



William D. McSpadden
Reg. No. 44,234
Baker & McKenzie
2001 Ross Avenue, Suite 2300
Dallas, TX 75201
Ph: (214) 978-3040
Fax: (214) 978-3099